

Office Action Summary

Application No.

10/517,564

Applicant(s)

DE KONING ET AL.

Examiner

Lawrence E. Crane

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on June 4, 2009 (Response).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-30,32,33,35 and 37-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,2,4-30,32,33,35 and 37-66 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>20090921</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

Claims **3, 31, 34 and 36** have been cancelled, no claims have been further amended, the Abstract has been amended, and no new claims have been added as per the response filed June 4, 2009. No additional or supplemental Information Disclosure Statements (IDSs) have been filed as of the date of this Office action.

Claims **1, 2, 4-30, 32, 33, 35 and 37-66** remain in the case.

Note to applicant: when a rejection refers to a claim **X** at line y, the line number “y” is determined from the claim as previously submitted by applicant in the most recent response including ~~lines deleted by line through~~.

An Examiner’s Amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 C.F.R. §1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the Issue Fee.

In claim **1** at line 3, following the term “and” the term -- dideaza-analogues and -- was inserted.

Authorization for this Examiner’s Amendment was given in a telephone interview with Richard F. Trecartin on September 21, 2009.

Restriction to one of the following inventions is required under 35 U.S.C. §121:

I. Claims **16-19, 52 and 55**, drawn to analogues of cyclic adenosine 3’, 5’-monophosphate with substituents optionally present at N⁶, at C-8, at C-2’, and attached to the phosphate-bonded divalent oxygen, pharmaceutical compositions thereof and methods of disease treatment therewith, classified in Class 536, subclass 26.13 and Class 514, subclass 47.

II. Claims **23-28 and 56-61**, drawn to isosters of cyclic adenosine 3’, 5’-cyclic phosphate wherein one or two adeninyl ring nitrogens have been replaced with carbon with substituents optionally present at multiple locations on the N-heteroring, at C-2’, and attached to the phosphate-bonded divalent oxygen, pharmaceutical compositions thereof and methods of

disease treatment therewith, classified in Class 536, subclasses 26.11 and 26.12 and Class 514, subclasses 43 and 48.

Claims **1, 2, 4-15, 20-22, 29, 30, 33, 35-51, 53, 54 and 62-66** link the inventions of Groups **I and II** and will be examined with the elected invention to the extent to which they apply.

The inventions are distinct, each from the other because of the following reasons:

Inventions **I and II** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP §§ 806.04 & 808.01). In the instant case the inventions of Group **I** and Group **II** have different functions, the generic classes of chemical compounds also claimed as active ingredients in each Group having chemically distinct structures.

Because these inventions are distinct for the reasons given above and 1) have acquired a separate status in the art as shown by their different classifications, 2) have acquired a separate status in the art because of their recognized divergent subject matter, and 3) the search required for the invention of Group **I** is not required for the invention of Group **II**, restriction for examination purposes as indicated is proper.

A telephone call was made to Richard F. Trecartin on September 21, 2009 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. §1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. §1.48(b) if one or more of the currently named inventors is no longer an inventor if at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. §1.48(b) and by the fee required under 37 C.F.R. §1.17(h).

Papers related to this application may be submitted to Group 1600 via facsimile transmission (FAX). The transmission of such papers must conform with the notice published in the Official Gazette (1096 OG 30, November 15, 1989). The telephone number to FAX (unofficially) directly to Examiner's computer is 571-273-0651. The telephone number for sending an Official FAX to the PTO is 571-273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner L. E. Crane whose telephone number is **571-272-0651**. The examiner can normally be reached between 9:30 AM and 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. S. Anna Jiang, can be reached at **571-272-0627**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is **571-272-1600**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status Information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see < <http://pair-direct.uspto.gov> >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

LECrane:lec
09/21/2009

/Lawrence E. Crane/

Primary Examiner, Art Unit 1623

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